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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,153	04/24/2000	Charles C. Brackett	15UL-5584	7268

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EXAMINER

FRENEL, VANEL

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/557,153

Applicant(s)

BRACKETT, CHARLES C.

Examiner

Vanel Frenel

Art Unit

3626

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed ~~amendment~~ ^{remarks} (s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 19-30.
Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER

See Continuation Sheet of 11 does Not place the application in condition for allowance because Applicant's Representative argues that: a) neither Campbell nor Brimm disclose or suggest dual-function graphical user interface screen displaying a list of exam descriptions. b) The Examiner has indulged in hindsight reconstruction of the claimed invention. c) Brimm does not disclose any screen for creating the task list or adding tasks to the list. d) The teachings of Brimm and Campbell are not combinable. The Examiner disagrees.

(A) With respect to Applicant first argument, Examiner respectfully submits that Brimm discloses "It would be desirable if the tasks on such task list could be charted by a system user while viewing the task list and if the associated form (s) were automatically updated at the same time that each task on the task list is completed by the user. Additionally, it would be desirable to be able to chart directly from the chronological task list that a particular intervention or procedure has been performed without leaving the context of the chronological task list" which correspond to Applicant's claimed feature (See Brimm, Col.3, lines 35-44). In addition, Brimm suggests "using the input means, entering onto the second form an indication that such task has been performed, and (i) automatically modifying the list of all tasks to reflect that such task has been performed" which correspond to Applicant's claimed feature (See Brimm, Col.4, lines 45-49). Therefore, Applicant argument is not persuasive.

(B) In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Therefore, Applicant's argument is not persuasive.

(C) With respect to Applicant second argument, Examiner respectfully submits that Campbell suggests "The diagnosis software uses the observations made during the medical exam to prepare a rule out list and prescribe a treatment protocol. Diagnosis software running on the server uses the observations to generate a list of abnormal observations and tentative diagnosis. The doctor can then select a tentative diagnosis by positioning the cursor over a diagnosis and selecting it. By selecting a tentative diagnosis, the user triggers the generation of a treatment protocol. This treatment protocol can then be integrated into future medical exam sessions. It is integrated because procedures that need to be performed and observations that need to be made are identified in the graphical exam screens in follow-up visits. Thus, once a treatment protocol is selected, the system manages the administration of that protocol in future exam sessions" which correspond to Applicant's claimed feature (See Campbell, Col.8, lines 3-17). Therefore, Applicant argument is not persuasive. In addition, Examiner respectfully suggests that Campbell discloses "to change information about the plan, the user can click on the "edit button" 2310 and then make the desired changes. For example, the user can change the status of the wellness plan from tentative to canceled by selecting the "canceled" status from the Contract Status list box 2308 which can also be used as a means of editing or modifying a list of description that Applicant is referring to (See Campbell, Col.28, lines 22-29). Furthermore, Examiner points out that Campbell suggests "The specific display format of the user interface screens can vary as well which is also another way of modification (See Campbell, Col.31, lines 55-56). Therefore, Applicant argument is not persuasive.

(D) With respect to Applicant third argument, Examiner respectfully submits that Campbell suggests "The physical exam buttons represent the top level in a hierarchy of physical exam screens. The physical exam is broken into the following areas: 1) Overall Condition 2) Coat and Skin 3) Ocular 4) Otic 5) Oral/Nasal 6) Respiratory 7) Cardiovascular 8) Abdominal 9) Urogenital 10) Perineal 11) Musculoskeletal 12) Neurological 13) Behavioral" which correspond to Applicant's claimed feature (See Campbell, Col.13, lines 12-36). In addition, Examiner respectfully submits that Campbell suggests "The therapy screen allows access to other screens such as the physical examination, the medical notes, diagnosis and ordering screens, via drop down menus, navigational controls, and user selection of therapy service items displayed on the screen. The therapy screen is accessible from other screens as well as via a drop down menu and navigational control buttons" which correspond to Applicant's claimed feature (See Campbell, Col.19, lines 6-11). Therefore, Applicant argument is not persuasive.

In response, all of the limitations which Applicant disputes as missing in the applied references, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Campbell and/or Brimm, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the prior Office Action, and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Others arguments presented appear to rehash issues addressed in the Finality Rejection of 03/11/05. Therefore, Applicant's argument is not persuasive and the finality is hereby sustained.